REMARKS

Claims 1-5, 9-16, 19, 20, 23-27, and 30-37 are pending. Claims 34-35 are allowed. Claims 1-5, 9-16, 19, 20, 23-27, 30-32, 36 and 37 are rejected. Claim 33 is objected to. Claim 32 is canceled herein. Claim 33 is amended herein. Claim 38 has been added herein.

Objection to Claim 33.

As suggested by the Examiner claim 33 has been rewritten in independent form including all of the base limitations of claim 32. Therefore, Applicant requests that Examiner withdraw the objection of claim 33.

Rejection of Claims 1-5, 9-16, 19, 20, 23-27, 30-32, 36 and 37 Under 35 U.S.C. §103.

Claims 1-5, 9-16, 19, 20, 23-27, 30-32, 36 and 37 are rejected under 35 U.S.C. §103 as being unpatentable by U.S. Pat. No. 5,027,781 to *Lewis* and in view of either legal precedent or official notice. However, the Examiner has not made a *prima facia* case of obviousness as required under patent law and in accordance with the Manual of Patent Examining Procedure ("MPEP").

To establish a *prima facie* case of obviousness the prior art references when combined must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The Examiner concedes that *Lewis* "fails to disclose that

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the exhaust gas stream heats the screen to a temperature sufficient to burn the captured particles; and that the screen is affixed to the intake pipe by interference fit." However, the Examiner contends that the claims are obvious because *Lewis* "fails to mention that the screen must be cleaned up occasionally to remove the trapped soot particles." Based on this contention, the Examiner concludes that it is obvious to one with ordinary skill that "the screen [of *Lewis*] is positioned such that the exhaust gas during a high load engine condition is hot enough to heat the screen to a temperature sufficient to burn the captured particles." However, the Examiner has not cited any teaching or suggestion within *Lewis* of a screen heated to a temperature to burn particles. In contrast, *Lewis's* specification clearly states the purpose of the screen by teaching that, "Mounting a **filter** (screen) 18 on the carbon gasket 19 provides a simple, rugged, **barrier** which prevents carbon flakes from entering the EGR valve system." (Emphasis added) (Col.3, ll. 44-46). Nothing in the specification teaches or suggests that the screen is positioned or heated to burn particles. One cannot conclude that the screen in *Lewis* is positioned or heated to burn particles based on the failure of the specification to teach cleaning the screen. Moreover, the deficiencies of references cannot be saved by appeals to common sense and basic knowledge without any evidentiary support. *In re Zurko*, 258 F.3d 1379 (Fed. Cir. 2001).

In fact, the *Lewis* reference is discussed at paragraph [005] of the present application. As set out there:

> For example, U.S. Pat. 5,027,781 [*Lewis*] discloses a stainless steel filter affixed to a gasket to provide a barrier to large carbon particles in the exhaust gas. However, these filters eventually are obstructed and clogged with large carbon particles as well. "

The Examiner has failed to provide any positive evidence that applicant's disclosure is inaccurate in this respect.

In addition, the Examiner contends that the limitation of the screen being *affixed to the intake pipe by interference fit* is a product-by-process claim. However, this limitation is clearly a structural limitation and not a process limitation. Claim limitations are interpreted as structural limitations when they adequately define a physical characteristic of the invention and are capable of being construed as a structural limitation. *In re Garnero*, 412 F.2d 276 (CCPA 1979), held that the limitation "interbonded one to another by interfusion" was "as capable of being construed as a structural limitation as 'intermixed,' 'ground in place,' 'press fitted,' 'etched,' and 'welded,' all of which at one time or another have been separately held capable of construction as structural, rather than process, limitations." (See MPEP §2113). Certainly, the limitation "affixed to an intake pipe by interference fit" is capable of being construed as a structural limitation under *In re Garnero*. As mentioned above, the Examiner concedes that Lewis fails to disclose the screen is affixed to the intake pipe by interference fit.

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For the reasons stated above, the Examiner has not established a *prima facie* case for obviousness of the afterburner of claims 1, 11, 36, and 37.

Claim 1 forms the basis for dependent claim 2-5, 7-10, and 36. Claim 11 forms the basis for dependent claim 12-16 and 19-20. Claim 23 forms the basis for dependent claim 24-27, 29-31, and 37. Because a dependent claim cannot be obvious if the independent claim from which it depends is not obvious, all claims depending from claims 1, 11, and 23 must also be found nonobvious.

In light of the above, Applicant therefore respectfully requests that the Examiner withdraw the rejection of claims 1-5, 9-16, 19, 20, 23-27, 30-31, 36 and 37 as being obvious under 35 U.S.C. § 103.

New Claim 38.

Claim 38 has been added. None of the references of record, either independently or in combination, teach or suggest the claimed subject matter of claim 38. Therefore, applicant submits that claim 38 constitutes allowable subject matter and should be favorably considered by the Examiner, and applicant respectfully requests that a timely Notice of Allowance be issued for such claim.

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Conclusion.

Applicant believes the above analysis and the amendments made herein overcome all of the Examiner's rejections and that Claims 1-5, 9-16, 19, 20, 23-27, and 30-31, and 33-38 are in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued for those claims.

The Commissioner is hereby authorized to charge any additional fees or credit overpayment under 37 CFR 1.16 and 1.17 which may be required by this paper to Deposit Account 162201.

Respectfully submitted,

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